



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,589	10/18/2000	Lirio Quintero	154-12786-US-CIP	5046

7590 03/19/2003

PAULA D. MORRIS  
Attorney at Law  
PAULA D. MORRIS & ASSOCIATES, P.C.  
2925 Briarpark Drive, Suite 930  
Houston, TX 77042

EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 03/19/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

# Office Action Summary

Application No.

09/691,589

Applicant(s)

QUINTERO, LIRIO

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/1/2000; 10/8/2002; and 12/17/2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 37-42 and 53-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 and 43-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2+10 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to the Information Disclosure Statement filed December 1, 2000, Paper No. 2; the Election filed October 8, 2002, Paper No. 8; and the granting of the petition to revive mailed December 17, 2002, Paper No. 9.

Claims 1-79 are pending. Claims 1-36 and 43-52 have been treated on the merits. Claims 37-42 and 53-79 have been withdrawn at this time.

#### ***Election/Restrictions***

1. Applicant's election of Group I, claims 1-36 and 43-52 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 37-42 and 53-79 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, Group II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

#### ***Priority***

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the

Art Unit: 1712

requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). Since the instant application is a CIP of the parent application, by definition of a CIP, the disclosure of the invention is different than that of the parent and therefore the provisional application.

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. While the instant application is a CIP of application number 09/426,172, said cross noting should include reference to the provisional application, which said parent application claimed benefit.

Applicants should update the cross-noting section at page 1, line 7, by inserting after "1999" the phrase - - , which claims benefit to provisional application number 60/105,502, filed October 23, 1998 - - .

#### ***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Art Unit: 1712

It identifies the provisional application having an improper filing date. The filing date of the provisional is October 23, 1998.

### ***Claim Objections***

5. Claims 50 and 52 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The range of "about 10 microns or less" is broader than the range "from about 3 microns to about 20 microns" since said range includes 0-3 microns. It is suggested applicants employ the range "about 3 microns to about 10 microns".

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-36 and 43-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the "media sufficiently acidic to initiate acid reactive polymerization" is unclear since it is unclear what is polymerized.

The scopes of the claims are indefinite since the claims employ open language when defining subgenus or species in an alternative grouping. See for example claim 2, employs "said anionic emulsifiers comprise" where claim 1 employs Markush language defining "emulsifiers selected from the group consisting of". It is unclear what are the

Art Unit: 1712

metes and bounds of the claimed subject matter sought to be patented. See also, claims 25-28 that contains the same issue.

It is unclear what applicants intend when defining the number of carbon atoms in the polyoxyethylene alcohols. For example, claim 2 sets forth "said polyoxyethylene alcohols comprise from about 8 to about 30 carbon atoms and from about 3 to about 50 moles of ethylene oxide". The number of carbon atoms and the number of ethylene oxide are in conflict since a polyoxyethylene methanol having 15 oxyethylene groups has 31 carbon atoms. See also, claims 3-6, 31-33 and 44-45.

Claims 7-9 employ improper Markush language. Said claims employ open language, "selected from the group consisting essentially of". Said claims further employ open language, "comprising" when defining the polyoxyethylene alcohols. See also claims 34 and 46.

In claims 10-15, the "ratio" is undefined, eg., wt/vol, weight, volume, or molar. Depending on how said ratio was to be defined, the scope of said ratio would differ.

In claims 31 and 44, "said polyoxyethylene alcohols" are defined twice with two different limitation scopes. It is unclear what applicants intend.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Otrhalek et al, US 4,032,466. Otrhalek et al (example 3 and claims, particularly claim 8) discloses compositions reading on the claims. Said compositions (all parts are by weight – see column 8, lines 509-62) comprise 12 parts alpha-alkyl-omega-hydroxy

Art Unit: 1712

poly(oxyethylene) with an average of 9 moles of oxyethylene, 4 parts of linear alkyl sulfonic acid, denoted as Calsoft LAS-99, and 30 parts of 37% hydrochloric acid. The nonionic (12) to anionic (4) ratio equates to 75/25, which reads on the claimed ratios. The pH would have been inherent to the 30 parts of the 37% hydrochloric acid. Typical pH of a 0.1N HCl solution is  $\text{pH} = 0.1$ . 0.1N equates to about a 3.6% hydrochloric acid solution. The concentration of the hydrochloric acid media of Otrhalek et al is an order of magnitude greater and would have been expected to have a pH of 1 or less.

9. Claims 1-9, 16-23 and 25-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lambremont et al, US 5,707,952. Lambremont et al (column 2, lines 38 et seq; example 1, table bridging columns 9 and 10; and claims, particularly claim 1) disclose aqueous acidic cleaners, which are in the form of microemulsions containing up to 2% by weight of water-insoluble hydrocarbon. Partentees claimed pH for the compositions may range from about 1 to about 4. Said range reads on the instantly claimed about 1 or less.

10. Claims 1-6 and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al, US 5,129,460. See examples, tables and claims.

11. Claims 1-15 and 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Taft, US 3,389,110. Taft (column 2, lines 49 et seq; examples and claims) discloses the claimed compositions. The claimed terms "polyoxyethylene alcohol" reads on the nonylphenol polyethylene glycol ether. The breadth of the term alcohol includes nonylphenol, which is an aromatic alcohol. The emulsion comprises an acidic pH of 5.2 for the free-radical polymerization of styrene, a hydrocarbon.

Art Unit: 1712

**Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
**Daniel S. Metzmaier**  
**Primary Examiner**  
**Art Unit 1712**

DSM  
March 14, 2003